

REMARKS

This communication responds to the Office Action mailed on March 3, 2008. Claims 1 and 15 are amended, no claims are canceled, and no claims are added. As a result, claims 1-7, 9, 15-19, and 21-24 are now pending in this Application.

§ 112 Rejection of the Claims

Claims 1-7, 9, 15-19 and 21-24 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate enablement. Since the Office has not properly established a *prima facie case* of non-enablement, the Applicant respectfully traverses.

First, it is respectfully noted that "... the specification and claims may not be rejected for lack of written description under Section 112, first paragraph, when details in the claims that are not described in the specification are within the level of ordinary skill in the art." See Patent Prosecution, Practice and Procedure Before The United States Patent Office, Ira H. Donner, 2002; citing *In re Skrivan*, 427 F.2d 801, (CCPA 1970). With this point in mind, it is respectfully noted that, contrary to the assertion by the Office, there is indeed disclosure of "a second panel mounted in front of the first panel, the second panel substantially encompassing the first panel to protect the conductive material of the first panel."

The Application as originally-filed states:

"Another alternative to the previously described display glass with an ITO coating is to use a second piece of glass behind the display glass. This second piece of glass would contain the ITO coating while the display glass would only contain the artwork for the display. The ITO glass position behind the display glass prevents the corruption of its integrity from outside sources." Application, pg. 8, lines 27-31.

Thus, one of ordinary skill in the art would easily understand how to use a second panel (e.g., display glass) mounted in front of the first panel (e.g., second piece of glass) to protect the conductive material (e.g., ITO coating), as described in the text of the Application.

Second, the M.P.E.P. § 2164 *et seq.* notes that the burden is on the Examiner to establish a *prima facie* case to maintain a rejection of non-enablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph. Such a case requires:

1. a rational basis as to
 - a. why the disclosure does not teach, or
 - b. why to doubt the objective truth of the statements in the disclosure that purport to teach;
2. the manner and process of making and using the invention;
3. that correspond in scope to the claimed invention;
4. to one of ordinary skill in the pertinent technology;
5. without undue experimentation; and
6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

"The Examiner must provide evidence ... supporting each of these elements for a rejection under the first paragraph of § 112 to be proper." See *Patent Prosecution, Practice and Procedure Before The United States Patent Office*, Ira H. Donner, pg. 691, 2002.

Since the specification clearly establishes the structural relationship between the claimed panels, and since evidence supporting each of the required elements noted above (e.g., that one of ordinary skill would be unable to practice embodiments of the invention without undue experimentation) has not been presented, a *prima facie* case to maintain a rejection of non-enablement under § 112, first paragraph, has not been properly established. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

§103 Rejection of the Claims

Claims 1-4, 6-7, 9, 15-16, 18-19 and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable by Wachi et al. (U.S. Patent 6,833,665 B2; hereinafter "Wachi") and Goodwin et al. (U.S. Patent 5,265,273; hereinafter "Goodwin") and in further view of Schneider (U.S. Patent 6,089,976). Claims 5 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wachi and Goodwin and Schneider, as applied to claims above, and further in view of Takahashi et al. (U.S. Patent 6,884,936 B2; hereinafter "Takahashi"). However, since a *prima facie* case of obviousness has not been properly established by the Office, the Applicant respectfully traverses the rejection of these claims.

1) *The Applicable Law*

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See* *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *See* *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *See* *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Moreover, the Examiner must avoid hindsight. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). That is, the Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *See* *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The fact that references can be combined or modified does not

render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

2) *Application of § 103 to the Rejected Claims*

First, the Office asserts that it is obvious to combine Goodwin with Wachi because "any conductive surface in which an electrical surface is attached to may provide the 'ground' necessary for the circuit to operate properly." If this is true, and since the assertion is unsupported by any evidence in the record, then either the Office is relying on inherency to reach this conclusion, or the Examiner is using personal knowledge.

If the Office relies on inherency then, as recited in MPEP § 2112, "... the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such basis has been provided. In fact, whether a particular conductive surface may be used successfully to provide a circuit ground depends on several factors, such as: the amount of current to be conducted, whether another potential is already coupled to the conductive surface, the number of attachment points needed for proper noise reduction, how the over-arching structure is to be assembled and disassembled for service, etc.

Since no inherent reason exists to support this assertion, the Examiner appears to be using personal knowledge. The Examiner is therefore respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2). If such is not provided, the only remaining conclusion is that it is not obvious to combine Goodwin with Wachi.

Second, none of the cited art references disclose the use of windows to view mechanical reels in a protected gaming machine display. Claims 1 and 15 recite, respectively:

A gaming machine, comprising:

a plurality of mechanical reels;

a visual display having windows to view the mechanical reels; ... (Claim 1, emphasis added)

An assembly for a gaming machine operative to conduct a wagering game, the assembly comprising:

a first panel positioned in front of a visual display of the machine and revealing at least a portion of the visual display, wherein **the visual display has windows to view a plurality of mechanical reels included in the gaming machine; ...** (Claim 15, emphasis added)

The amendments to claims 1 and 15 that add these features are fully supported by the Application as-filed, and thus, no new matter has been added. *See* Application, page 6, lines 3-8. No single cited reference, or any combination of the cited references, provides these claimed features.

In addition, it is not obvious to provide this capability, as it serves to increase the expense of manufacturing a gaming machine. This is because the display alone can be used to provide images of reels, without adding the additional expense of providing windows in the display, along with mechanical reels. Thus, even if the cited art did disclose each the elements claimed, one of ordinary skill in the art would have no reason to combine the references to provide this type of operation because of the added expense and pre-existing capability of the display.

Therefore, independent claims 1 and 15, reciting the use of a protected display structure having windows for viewing mechanical reels in a gaming machine, are nonobvious. In addition, any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03. Thus, claims 2-14 and 16-24 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-7, 9, 15-19, and 21-24 under 35 U.S.C. § 103(a).

CONCLUSION

The Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicants' attorney at 210-308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date June 25, 2008

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 25 day of June 2008.

Zhakalazky M. Carrion

Name

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Signature